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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | |
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| | | ITL.0658US (P11212) | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 101.11(a)] on <u>January 11, 2006</u> Signature <u>Cynthia L. Hayden</u> Typed or printed name <u>Cynthia L. Hayden</u> | | Application Number | Filed |
| | | 09/930,779 | August 15, 2001 |
| | | First Named Inventor | |
| | | Jeremy Burr | |
| | | Art Unit | Examiner |
| | | 2682 | Tuan A. Tran |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. | | | |
| This request is being filed with a notice of appeal. | | | |
| The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | |
| I am the | |  | |
| <input type="checkbox"/> applicant/inventor. | | Signature | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | | Timothy N. Trop | |
| <input checked="" type="checkbox"/> attorney or agent of record. | | Typed or printed name | |
| Registration number <u>28,994</u> | | (713) 468-8880 | |
| | | Telephone number | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. | | January 11, 2006 | |
| Registration number if acting under 37 CFR 1.34 _____ | | Date | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*. | | | |



*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Jeremy Burr

Serial No.: 09/930,779

Filed: August 15, 2001

For: Establishing Communications
Between Devices Within a Mobile
Ad Hoc Network

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Art Unit: 2682

Examiner: Tuan A. Tran

Docket: ITL.0658US
P11212

Assignee: Intel Corporation

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pre-appeal review is requested because it is believed that the only possible basis for the rejection is one of inherency. However, in order to make out a rejection that is based on the element being inherent, is not sufficient if a certain result or characteristic may occur or be present in the prior art. See M.P.E.P. § 2112, page 2100-57, "The Examiner must provide rationale or evidence tending to show inherency." Instead, the result must necessarily adhere.

Here, the claim requires that a contact list for a first wireless device be obtained. That contact list should include in-range device and out-of-range devices and both the in-range and out-of-range devices must be devices which the first wireless device has communicated with in the past.

Date of Deposit: January 11, 2006

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Cynthia L. Hayden
Cynthia L. Hayden

The applicant contends that, while there are in-range and out-of-range devices in the list prepared in the reference, the out-of-range devices are not devices with which the first wireless device has communicated with in the past.

The reason for this position is that the reference merely states that the list is compiled of in-range devices and devices that the in-range devices have communicated with. Therefore, the first wireless device need not have communicated with any of those out-of-range devices.

Thus, the issue comes down to whether or not the reference teaches that, necessarily, the list includes devices which the first wireless device has communicated with in the past and which are out-of-range. Mere accidental or unintentional acts are not sufficient. It is necessary that the reference teach something which necessarily occurs. See M.P.E.P. § 2112.

Here, all we know is that out-of-range devices are put on the list only because they have communicated with in-range devices (other than the first wireless device). However, that list need not include out-of-range devices with which the first wireless device has communicated with in the past. That is because the only requirement in the reference is that in-range devices have the out-of-range devices listed in their lists. There is no reason to presume that those out-of-range devices would necessarily have been the subject of communications with the first wireless device whose list is being compiled.

Federal Circuit decisions emphasize that an anticipatory inherent feature or result must be consistent, necessary, and inevitable, not merely possible or probable. See *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1373, 62 U.S.P.Q.2d 1865 (Fed. Cir. 2002) (“anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation ...”); *Mehl/Biophile International Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 U.S.P.Q.2d 1303 (Fed. Cir. 1999) (“Occasional results are not inherent.”); *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (the PTO Board erred in holding that a prior art reference anticipated by inherency an applicant’s claim, which concerned a diaper fastening and disposal system; the Board’s analysis rested on mere probability or possibility, i.e., that elements in the reference could be used other than as disclosed and for a different function (“odd use”); such probability or possibility is not sufficient to establish inherency); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303 (Fed. Cir. 1983) (“Anticipation of inventions set forth in product claims cannot be

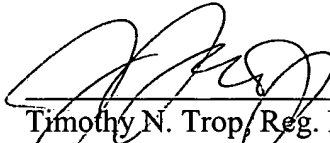
predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in the references.”).

The Examiner is suggesting that, sometime in the practice of the invention disclosed in the reference, it might be possible that an in-range device would have an out-of-range device on its list that the first wireless device has communicated with in the past. However, this is insufficient as expressly found, for example, in the *Robertson* case and the *Gore v. Garlock* cases, to make out an inherency rejection.

Since none of the prior art teaches populating the list on a first wireless device with both in-range and out-of-range devices with which the first wireless device has communicated in the past, the rejection should be reconsidered.

Respectfully submitted,

Date: January 11, 2006



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